

3-1-2011

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## Recommended Citation

Elizabeth Ferrill & Tina Tanhehco, *Protecting the Material World: The Role of Design Patents in the Fashion Industry*, 12 N.C. J.L. & TECH. 251 (2011).

Available at: <http://scholarship.law.unc.edu/ncjolt/vol12/iss2/2>

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**PROTECTING THE MATERIAL WORLD: THE ROLE OF DESIGN  
PATENTS IN THE FASHION INDUSTRY**

*Elizabeth Ferrill\* & Tina Tanhehco\*\**

*Design patents are an under-utilized tool in the protection of the work of fashion designers. Although the fashion industry annually generates billions of dollars in sales in the United States alone, many designers do not adequately protect their intellectual property. Multiple efforts to create a sui generis<sup>1</sup> statute specifically for fashion designs have stalled in Congress, but, the growing market of nearly-identical copied goods—known as knockoffs—threatens the authentic fashion industry. As a result, both high-end and emerging designers suffer. While a statute specifically protecting fashion designs does not yet exist under American law, fashion designers can find protection under the existing laws with design patents. This article will illustrate how knockoff goods present a particularly serious problem in the digital age, consider why designers may choose not to protect their work with the existing intellectual property protections, and show how design patents offer an economically feasible, effective way for fashion designers to protect many of their designs.*

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\*Associate, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP. Ms. Ferrill would like to thank Stephen Peterson for his guidance and assistance with this article.

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<sup>1</sup> See *The Oxford Dictionary and Thesaurus* 1528 (Oxford University Press, American Ed., 1996) (meaning “Latin, literally ‘of its own kind’”).

## I. INTRODUCTION

*"Fashion is not something that exists in dresses only.  
Fashion is in the sky, in the street, fashion has to do  
with ideas, the way we live, what is happening."*<sup>2</sup>  
—Coco Chanel

Gabrielle Chanel, popularly referred to as "Coco," was born in 1883 amidst a world of corsets and other confining garments.<sup>3</sup> But by the time she died in 1971, her Chanel suit with its collarless jacket and well-fitted skirt and her "little black dress" were timeless classics.<sup>4</sup> Today, Ms. Chanel's company continues to thrive under the leadership of designer Karl Lagerfeld.<sup>5</sup> But despite their immense success, Ms. Chanel and Mr. Lagerfeld have something in common with every first-year fashion design student—none of them have intellectual property laws specifically designed to protect fashion.<sup>6</sup>

The fashion industry in America is well-known for lacking specially-tailored intellectual property protection.<sup>7</sup> Early efforts at a sui generis statute were struck down by the United States Supreme Court as anticompetitive.<sup>8</sup> In contrast, European fashion designs can receive twenty-five years of protection.<sup>9</sup> While there have been two recent attempts at modifying the U.S. copyright

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<sup>2</sup> *Coco Chanel Quotes*, THINKEXIST.COM, [http://thinkexist.com/quotes/coco\\_chanel/](http://thinkexist.com/quotes/coco_chanel/) (last visited Mar. 16, 2011).

<sup>3</sup> A&E Television Networks, *Coco Chanel Biography*, BIOGRAPHY.COM., <http://www.biography.com/articles/Coco-Chanel-9244165> (last visited Mar. 26, 2011).

<sup>4</sup> *Id.*

<sup>5</sup> *See id.*

<sup>6</sup> *See* Diane Von Furstenberg, *Fashion Deserves Copyright Protection*, L.A. TIMES, Aug. 24, 2007, <http://www.latimes.com/news/opinion/la-oev-furstenberg24aug24,0,1109807.story> (arguing that America should adopt stricter regulations on piracy, like many European countries).

<sup>7</sup> *See id.* (noting that foreign manufacturers can steal U.S. designs, manufacture them, and import the knockoffs back into the U.S.).

<sup>8</sup> James Surowiecki, *The Piracy Paradox*, THE NEW YORKER, Sept. 24, 2007, at 90, available at [http://www.newyorker.com/talk/financial/2007/09/24/070924ta\\_talk\\_surowiecki](http://www.newyorker.com/talk/financial/2007/09/24/070924ta_talk_surowiecki) (holding that a group of manufacturers that formed the Fashion Originators Guild of America to stifle counterfeiters in the marketplace was illegal).

<sup>9</sup> Von Furstenberg, *supra* note 6.

statute to carve out additional protection for fashion designs, neither attempt has yet become law. The Design Piracy Prohibition Act of 2006 failed to make it out of Congress and the Innovative Design Protection and Piracy Prevention Act of 2010 was placed on the Senate Legislative Calendar in December 2010 and has not moved forward since that time.<sup>10</sup> Copyright, however, is not the only method of protection that designers should consider. Though often overlooked by academics, design patents offer one potential type of protection for fashion designs. Design patents provide patent protection to inventors of new, original, and ornamental design for an article of manufacture.<sup>11</sup> Strategically applied, design patents can exclude others from using their designs for at least 14 years, if not in perpetuity, should those designs acquire distinctiveness<sup>12</sup> during the design patent protection period.<sup>13</sup>

This article posits that legal protections are necessary safeguards for fashion designers against knockoff products, and it will show that design patents are not only relevant to the fashion industry, but could provide protection for fashion products. In Part I, the article will highlight the importance of fashion in economic and cultural terms. In Part II, it will examine the current threat to the industry posed by knockoff products. Part III analyzes the need for intellectual property protection in fashion, and Part IV discusses some of the traditional intellectual property solutions for fashion. Finally, Part V argues that design patents currently present a practical and efficient form of protection for fashion design often underutilized.

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<sup>10</sup> Innovative Design Protection and Piracy Prevention Act, S. 3728, 111<sup>th</sup> Cong. (2010).

<sup>11</sup> 35 U.S.C. § 171 (2006).

<sup>12</sup> Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 210–211 (2000).

<sup>13</sup> *Samara Bros., Inc.*, 529 U.S. 205; 1502.01 Distinction Between Design and Utility Patents [R-2], MPEP (8th ed. Rev. 7, Sept. 2008), available at [http://www.uspto.gov/web/offices/pac/mpep/mpep\\_e8r5\\_1500.pdf](http://www.uspto.gov/web/offices/pac/mpep/mpep_e8r5_1500.pdf); Victoria R. Watkins, *Copyright and the Fashion Industry*, January/February 2011, A.B.A. SEC. INTELL. PROP. L. at 53, 55.

## II. BACKGROUND

### A. *Distinction Between Knockoffs and Counterfeits*

In the fashion world, designers must combat two arch enemies—knockoffs and counterfeits. While the two terms are used interchangeably in various contexts,<sup>14</sup> this paper will distinguish them as separate terms. A counterfeit represents a nearly exact duplicate of an item sold with the intent to be passed off as the original.<sup>15</sup> Conversely, a knockoff is a close copy of the original design, mimicking its elements, but is not sold in an attempt to pass as the original.<sup>16</sup>

For example, a counterfeit may appear on the streets or in a back room where a black market seller will try to get a buyer to purchase a bag with the exact same design and logo of a high-end designer, like Chanel.<sup>17</sup> In the past decade, the Internet, including sites like eBay, offers faster and more efficient ways for counterfeited goods to reach consumers.<sup>18</sup>

The knockoff manufacturers, however, will not use the exact Chanel logo or design. Instead, they may make a close copy by mimicking Chanel's classic suit jacket—using a similar shape, similar print, and similar materials. Examples of knockoffs can be found on Web sites advertising where to find the knockoff as well

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<sup>14</sup> See Diane O'Brien, *When Imposters Knock Off Profits*, BRANDCHANNEL, (Dec. 1, 2003), [http://www.brandchannel.com/features\\_effect.asp?pf\\_id=187](http://www.brandchannel.com/features_effect.asp?pf_id=187); see also TIM PHILLIPS, *KNOCKOFF: THE DEADLY TRADE IN COUNTERFEIT GOODS* (2005).

<sup>15</sup> *Counterfeit Definition*, MERRIAM-WBSTER.COM, <http://www.merriam-webster.com/dictionary/counterfeit> (last visited Mar. 22, 2011).

<sup>16</sup> *Knockoff Definition*, MERRIAM-WBSTER.COM, <http://www.merriam-webster.com/dictionary/knockoff> (last visited Mar. 22, 2011).

<sup>17</sup> Emma, *The Economy, Counterfeiting and Canal Street*, STOLEN STYLE BLOG (Feb. 7, 2011, 8:37 AM), <http://stolenstyleblog.blogspot.com/2011/02/economic-effects-of-counterfeiting.html> (citing example of Gucci, another high-end brand like Chanel, bags sold on the street as a tourist draw to New York City).

<sup>18</sup> Katrina M. Klatka, *Policing Counterfeit Goods Sold on eBay*, HAHN LOESER, <http://www.hahnloeser.com/references/796.pdf> (last visited Apr. 11, 2011).

as celebrating the very existence of the knockoff.<sup>19</sup> In a post on *intheircloset.com* entitled “Real vs. Steal—Sigerson Morrison Huarache Stiletto Sandals,” the cost (\$394.20) and photograph of the original design by Huarache sandal are shown. The post then offers viewers the alternative close copy of the sandal sold by Enzo Angiolini (\$99). The Angiolini is not an exact copy of the Huarache, but it is very similar:



**Figure 1:** *Original Huarache Stiletto Sandals*<sup>20</sup>



**Figure 2:** *Angiolini “Beehive” Sandal*<sup>21</sup>

Notably, the Enzo Angiolini shoes have only four sets of straps of three, five, four, and three straps each, whereas the Huarache shoes have five sets of straps, with each set having four. Thus, the Enzo Angiolini shoes could be categorized as knockoffs because of their close resemblance to the original design.

<sup>19</sup> See Celine, *Real vs. Steal—Casadei 3114 Satin Platform Pumps*, IN THEIR CLOSET (May 18, 2010), <http://intheircloset.com/casadei-3114-satin-platform-pumps/>.

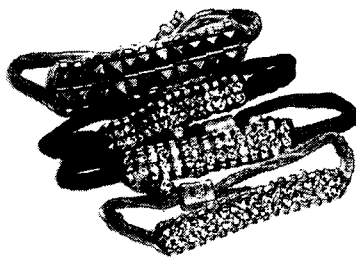
<sup>20</sup> Vahni Georgoulakos, *Real vs. Steal—Sigerson Morrison Huarache Stiletto Sandals*, IN THEIR CLOSET (May 14, 2010), <http://intheircloset.com/sigerson-morrison-huarache-stiletto-sandals/>; *Sigerson Morrison Sm9338*, 6PM, <http://www.6pm.com/product/7495624/color/5291> (last visited Apr. 11, 2011) (showing a price decrease in the originals online to \$240.90).

<sup>21</sup> Georgoulakos, *supra* note 20; Enzo Angiolini Women's Beehive Sandal, ENDLESS, [http://www.endless.com/dp/B0039YP3WE/185-3938930-8206411?ie=UTF8&camp=1789&creative=9325&suppressRedirect=1&linkCode=as2&tag=intheircloset-20&creativeASIN=B0039YP3WE&\\_encoding=UTF8](http://www.endless.com/dp/B0039YP3WE/185-3938930-8206411?ie=UTF8&camp=1789&creative=9325&suppressRedirect=1&linkCode=as2&tag=intheircloset-20&creativeASIN=B0039YP3WE&_encoding=UTF8) (last visited Mar. 22, 2011).

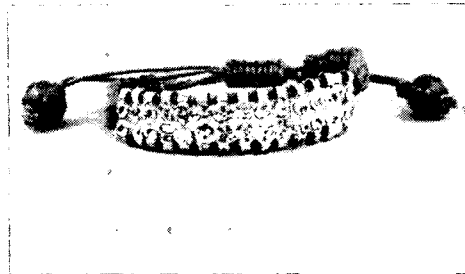
While counterfeit goods are regulated by trademark law and the Lanham Act,<sup>22</sup> knockoffs are not specifically prohibited by any U.S. law. Though counterfeiting is undoubtedly a problem, some argue that knockoffs represent an even greater threat to the fashion world, partly because knockoffs have become so widespread, and partly because they have the ability to harm designers in a real way—economically and creatively, by taking away the incentive to create original design.<sup>23</sup>

#### B. *Knockoffs Can Stall the Rise of Emerging Designers*

Two emerging designers, Yuvi Albert and Danna Kobo, created the Shashi bracelet. The bracelet has evolved into various forms now sold under the Shashi name:



**Figure 3:** *Shashi White Gold Two Row Crystal Bracelet*<sup>24</sup>



**Figure 4:** *Shashi Double Row Crystal Bracelet*<sup>25</sup>

<sup>22</sup> Lanham (Trademark) Act, 15 U.S.C. § 22 (2006).

<sup>23</sup> See *Origins: into the rule-based trade system.*, WTO, [http://www.wto.org/english/thewto\\_e/whatis\\_e/tif\\_e/agrm7\\_e.htm](http://www.wto.org/english/thewto_e/whatis_e/tif_e/agrm7_e.htm) (last visited Mar. 22, 2011) (“Society benefits in the long term when intellectual property protection encourages creation and invention, especially when the period of protection expires and the creations and inventions enter the public domain.”); Christine Magdo, *Protecting Works of Fashion from Design Piracy* (last visited Apr. 11, 2011) (unpublished student paper Harvard University) available at <http://leda.law.harvard.edu/leda/data/36/MAGDO.pdf>.

<sup>24</sup> *Shashi: Delicate White Gold Two-Row Crystal Bracelet*, INTERMIX, [http://s7d2.scene7.com/s7ondemand/zoom/flasht\\_zoom.jsp?company=Intermix&zoomwidth=700&zoomheight=550&config=ZoomSkin&sku=D2RWG\\_210&windowtitle=www.intermixonline.com-Intermix&vc=image=Intermix/D2RWG\\_210;Intermix/sw\\_210](http://s7d2.scene7.com/s7ondemand/zoom/flasht_zoom.jsp?company=Intermix&zoomwidth=700&zoomheight=550&config=ZoomSkin&sku=D2RWG_210&windowtitle=www.intermixonline.com-Intermix&vc=image=Intermix/D2RWG_210;Intermix/sw_210) (last visited Mar. 22, 2011).

In a seven-month period in 2009, more than 10,000 Shashi bracelets were sold at approximately \$60 each.<sup>26</sup> Shashi bracelets soon graced the wrists of fashion forward stars such as Katy Perry and Lindsay Lohan.<sup>27</sup> Shortly after Christmas of that year, nearly a thousand American Eagle stores<sup>28</sup> began selling a “striped beaded bracelet” that the Shashi designers alleged was a knockoff version.<sup>29</sup>



**Figure 5:** *American Eagle Outfitter's Braided Rhinestone Bracelet*<sup>30</sup>

The American Eagle version sold at \$12.50.<sup>31</sup> By April 2010, the Shashi designers had filed for design patent protection and retained

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<sup>25</sup> *The Look for Less: Shashi Double Row Crystal Bracelet*, THE BUDGET BABE (Mar. 23, 2010, 3:11 PM), <http://www.thebudgetbabe.com/archives/2478-The-Look-for-Less-Shashi-Double-Row-Crystal-Bracelet.html>.

<sup>26</sup> Christina Binkley, *The Problem With Being a Trendsetter: Copycat Fashions Move Faster Than Ever, Making It Harder to Protect Original Ideas; Smaller Designers Bear the Brunt*, WALL ST. J. (Apr. 29, 2010), <http://online.wsj.com/article/SB10001424052748704423504575212201552288996.html>; *Shashi Bracelets*, POLYVORE, [http://www.polyvore.com/shashi\\_bracelets/shop?brand=Shashi&category\\_id=106](http://www.polyvore.com/shashi_bracelets/shop?brand=Shashi&category_id=106) (last visited Mar. 22, 2011).

<sup>27</sup> Binkley, *supra* note 26.

<sup>28</sup> American Eagle Outfitters, Inc., Annual Report (Form 10-K) (Mar. 26, 2010), available at [http://www.fqs.org/sec-filings/100326/AMERICAN-EAGLE-OUTFITTERS-INC\\_10-K/](http://www.fqs.org/sec-filings/100326/AMERICAN-EAGLE-OUTFITTERS-INC_10-K/).

<sup>29</sup> Binkley, *supra* note 26.

<sup>30</sup> *The Look for Less: Shashi Double Row Crystal Bracelet*, *supra* note 25.

<sup>31</sup> Binkley, *supra* note 26.



an attorney to enforce their rights.<sup>32</sup> But the knockoffs had already infiltrated the market, undoubtedly costing the Shashi designers significant business.

As a small business, the Shashi bracelet designers could have obtained design patents for potentially less than \$10,000, or the retail cost of about 160 bracelets.<sup>33</sup> Even before the design patent issued, the designers could have marked their product (or its tag) with “patent pending,” notifying would-be knockoff manufacturers of Shashi’s pending intellectual property rights. This marking alone might deter some offenders. But if not, then they may be able to recover enhanced monetary damages if the infringer is found to have committed willful infringement. Also, the designers need not have filed the patent application immediately, just within one year of the first sale of the bracelets.<sup>34</sup> Furthermore, the process of obtaining the patents could have been expedited when the infringement became known.<sup>35</sup>

### C. *A Big Money Business*

Fashion is serious business. In just one month, the sales for clothing and accessories in the United States alone reached more than \$15.9 billion.<sup>36</sup> An annual report from 2008 by the U.S. Census Bureau estimates nearly \$217 billion in annual sales for clothes and accessories, with shoes sales reaching over \$27 billion in annual sales through retail.<sup>37</sup> On a global scale, the knockoff industry is estimated to be \$30 billion, with various hands wanting

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<sup>32</sup> *Id.*

<sup>33</sup> See *Design Patents and the Fashion Industry*, PATENTLYO (Dec. 6, 2010, 10:08 PM), <http://www.patentlyo.com/patent/2010/12/design-patents-and-the-fashion-industry.html> (showing that most PTO fees for small entities are half of the standard fees).

<sup>34</sup> 35 U.S.C. § 102(b) (2006).

<sup>35</sup> 37 C.F.R. 1.155 (under Expedited Examination of Design Application).

<sup>36</sup> *Monthly & Annual Retail Trade*, U.S. CENSUS BUREAU, <http://www.census.gov/retail/> (last visited Mar. 22, 2011) (follow “Table 1” hyperlink under “Advance Monthly Trade Report” for month of Feb. 2011).

<sup>37</sup> U.S. CENSUS BUREAU, ESTIMATED ANNUAL SALES OF U.S. RETAIL AND FOOD SERVICES FIRMS BY KIND OF BUSINESS: 1992 THROUGH 2009, *available at* <http://www2.census.gov/retail/releases/current/arts/sales.pdf> (last visited Mar. 22, 2011).

a piece of the pie, including large department retailers like JCPenney.<sup>38</sup> In New York City alone, considered “the fashion capital” of the world,<sup>39</sup> the fashion industry produces “over \$1.7 billion tax revenue with \$9 billion in total wages.”<sup>40</sup> As a result of the counterfeit and knockoff industry in 2004 alone—including all goods such as fashion, accessories, and multimedia—New York lost \$1 billion tax revenue with the comptroller estimating over \$23 billion worth of knockoff goods sold.<sup>41</sup>

Of course, the retail price for a single item from a high-end designer is often more money than what most people will earn in a week, if not a month.<sup>42</sup> This season’s shoppers can buy the \$13,000 “sukey” large tote bag from Gucci,<sup>43</sup> or some may purchase a prestigious Hermes “Birkin” bag—a luxury item that became a huge phenomenon within the fashion world—for the *used* price of \$8,000.<sup>44</sup>

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<sup>38</sup> Barbara Thau, *Can Department Stores Knock Off Fast-Fashion Strategy?*, CNBC: CONSUMER NATION (Oct. 18, 2010, 2:05 PM), [http://www.cnbc.com/id/39688970/Can\\_Department\\_Stores\\_Knock\\_Off\\_Fast\\_Fashion\\_Strategy](http://www.cnbc.com/id/39688970/Can_Department_Stores_Knock_Off_Fast_Fashion_Strategy).

<sup>39</sup> *Mayor Bloomberg and fashion industry leaders call for immigration reforms*, TIMES SQUARE (Feb. 21, 2011, 12:38 AM), [http://www.timessquare.com/New\\_York\\_City/NYC\\_Features/Mayor\\_Bloomberg\\_and\\_fashion\\_industry\\_leaders\\_call\\_for\\_immigration\\_reforms/](http://www.timessquare.com/New_York_City/NYC_Features/Mayor_Bloomberg_and_fashion_industry_leaders_call_for_immigration_reforms/).

<sup>40</sup> *Id.*

<sup>41</sup> Eric Dash, *The Handbag? Total Knockoff. The Price Tag? All Too Real.*, N.Y. TIMES (Nov. 23, 2004), <http://www.nytimes.com/2004/11/23/nyregion/23counterfeit.html>.

<sup>42</sup> NLRB News Release USDL-10-1045 (Jul. 27, 2010), *available at* <http://www.bls.gov/news.release/pdf/ocwag2.pdf> (showing annual wages earned per occupation, and exhibiting that in some occupations, one would need to accumulate more than one year of earnings to afford even just one high-end handbag); *Using a Month’s Salary to Buy a Wallet?*, OKSTY (Sept. 16, 2010), <http://www.oksty.com/uncategorized/using-a-months-salary-to-buy-a-wallet.html>; Corrine Wu, *Is It Worth Spending One Month’s Salary on Buying a Wallet?*, EZINE @RTICLES (Oct. 18, 2010), <http://ezinearticles.com/?Is-It-Worth-Spending-One-Months-Salary-on-Buying-a-Wallet?&id=5222430>.

<sup>43</sup> ‘sukey’ large tote with detachable interlocking G charm, GUCCI, <http://www.gucci.com/us/styles/211943EIJOG2208#> (last visited Apr. 11, 2011).

<sup>44</sup> *Guaranteed Authentic. HERMES Birkin Bag 35cm Black N stamp*, BONANZA, [http://www.bonanza.com/booths/theebags/items/Guaranteed\\_Authentic\\_HERMES\\_Birkin\\_Bag\\_35cm\\_Black\\_N\\_stamp](http://www.bonanza.com/booths/theebags/items/Guaranteed_Authentic_HERMES_Birkin_Bag_35cm_Black_N_stamp) (last visited April 2,



**Figure 6: Gucci's Sukey Large Tote<sup>45</sup>**



**Figure 7: Hermes Birkin Bag<sup>46</sup>**

These items are so desirable and expensive that a new market has emerged, allowing people to rent high-end fashion goods if they cannot afford to own the high price tag items.<sup>47</sup>

Moreover, modern fashion designers do not limit themselves to

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2011); Rick Karr, *Fashion Industry Copes with Designer Knockoffs: With Copyright Protection Elusive, Copies are Common*, NPR (Sept. 18, 2003), <http://www.npr.org/templates/story/story.php?storyId=1434815> ("If you find yourself attracted to, say, a handbag in an upscale Soho boutique but it costs too much, head a few blocks south to Canal Street. You'll probably find the design that caught your eye on a table on the sidewalk selling for a lot less: A knockoff of a \$600 Prada bag, for example, goes for around 100 bucks. Joseph Gioconda is an attorney with Kirkland and Ellis, a firm that represents the French design house Hermes. He's charged with keeping knockoffs of the company's bags, scarves and accessories off the street—and the Internet, where a crude copy of a \$5,000 Hermes 'Birkin' bag might be had for less than \$30."); The Birkin Bag is mentioned on an episode of *Gilmore Girls*, dealing with issues of socioeconomic status. When one wealthy character on the show nonchalantly gives his girlfriend a Birkin, it causes a large amount of buzz and stress among all characters on the show. *The Gilmore Girls: Welcome to the Dollhouse* (WB television broadcast Oct. 18, 2005).

<sup>45</sup>GUCCI, *supra* note 43.

<sup>46</sup>*Hermes Tan Gold 30CM 35CM Birkin Bag Togo Leather*, ETUI MAISON, [http://www.etuimaison.com/product\\_info.php?products\\_id=148](http://www.etuimaison.com/product_info.php?products_id=148) (last visited Mar. 22, 2011) (selling a Hermes Birkin Bag for \$1,325).

<sup>47</sup>AVELLE, <http://www.bagborroworsteal.com/welcome> (last visited Mar. 22, 2011).

clothing. With an entire line of products,<sup>48</sup> Polo Ralph Lauren made “product revenues of \$2.3 billion in 2004 but generated \$5 billion in revenue from licensed products such as bed sheets and eyewear.”<sup>49</sup> Fashion even attracts designers and artists from other disciplines. Sean Jean Combs, also known as Puff Daddy, P. Diddy, and Diddy, has had a prolific music career. He won multiple Grammy awards before starting his own fashion line, “SeanJean.” In its first year, SeanJean garnered \$150 million in sales which increased nearly five-fold within five years.<sup>50</sup>

Understandably, high prices and large demand create a healthy market for lower-priced knockoff goods. But even knockoffs can be quite expensive. For example, design house Faviana’s “Dress Like A Star” line offers look-a-like gowns from the Golden Globes and the Oscars, approximately two months after the ceremonies, for as much as \$500.<sup>51</sup> Faviana says they allow their customers to have “bling-on-a-budget,”<sup>52</sup> but their prices are far from bargain basement.

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<sup>48</sup> Designers can create fashion lines that may be subsidiaries to their main line of business. Also, celebrities are increasingly starting fashion lines of their own. Recently, Emma Watson, an actress who gained fame playing Hermione in the Harry Potter movies and who is currently the face of Burberry, partnered with Alberta Ferretti, a luxury name brand designer to create an ethically made green line of 100% organic and Fair-Trade certified cotton handmade clothes. Sharon Feiereisen, *Emma Watson and Alberta Ferretti Launch Green Clothing Line*, THE FASHION SPOT (Mar. 4, 2011), <http://www.thefashionspot.com/celebrity-fashion/news/128057-emma-watson-and-alberta-ferretti-launch-green-clothing-line>.

<sup>49</sup> Lauren Howard, *An Uningenious Paradox: Intellectual Property Protections for Fashion Designs*, 32 COLUM. J.L. & ARTS 333, 352 (2009).

<sup>50</sup> See SEANJEAN, <http://www.seanjohn.com/> (Apr. 11, 2011); see also *SeanJean: Latest Shows*, NY MAG, <http://nymag.com/fashion/fashionshows/designers/bios/seanjohn/> (last visited Mar. 22, 2011).

<sup>51</sup> *About Us: Making Dreams a Reality . . .*, FAVIANA, <http://www.faviana.com/page-about-us> (last visited Mar. 22, 2011).

<sup>52</sup> *Id.*

#### D. *The Fashion Industry Relies on Trends*

The root of the word “trend” comes from Middle English, meaning “to turn” or “to revolve.”<sup>53</sup> In fashion, “trend” is used synonymously with a fad or passing style which sweeps through seasons. A trend may last as short as a few weeks or as long as a few years. “The desire to be ‘in fashion’ . . . captures a significant aspect of social life, characterized by both the pull of continuity with others and the push of innovation toward the new.”<sup>54</sup> Trends are a part of most creative industries, and they are often associated with fashion: “Styles, as we all know, rise and fall in a ceaseless cycle of trends . . . . As copies of trendy or noteworthy garments are freely made, fashion-forward consumers recognize that it’s time to jump to the next new thing. The fashion cycle turns even faster.”<sup>55</sup>

While some trends begin on the runways, others begin on the street.<sup>56</sup> Trends may begin with an idea or a look from a high-end designer, a celebrity, or even a consumer. For instance, imagine that Kim Kardashian decides to wear leopard print booties.<sup>57</sup> Suddenly, pictures of her wearing the booties appear all over the internet and on television, and everyone wants shoes just like hers.

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<sup>53</sup> *Trend Definition*, MERRIAM-WEBSTER.COM, <http://www.merriam-webster.com/dictionary/trend> (last visited Mar. 15, 2011).

<sup>54</sup> C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1149–1150 (2009).

<sup>55</sup> Kal Raustiala & Chris Sprigman, *Is the Design Piracy Prohibition Act a Good Idea?*, FREAKONOMICS.COM (Mar. 12, 2010), <http://freakonomics.blogs.nytimes.com/2010/03/12/should-fashion-be-protected-by-copyright-laws-a-guest-post/>.

<sup>56</sup> DIANA CRANE, *FASHION AND ITS SOCIAL AGENDAS: CLASS, GENDER, AND IDENTITY IN CLOTHING* 165 (2000). “One forecaster described the process in an interview: ‘We take from what we see happening with some key designers. There are five or six designers who come to the fore and who really set the trend. The more you do this, the more it becomes a science; you know who to watch by going to the collections . . . . And then as a forecaster, I go back to that original inspiration, to see what was turning him on and how that relates to the present moment in time and why he might have connected to it, what stimulated him, and why that’s meaningful.’ ” *Id.*

<sup>57</sup> *2011 Dress Like the Celebrities: Kim Kardashian*, NUFASHIONTRENDS.COM (Oct. 28, 2010), <http://www.nufashiontrends.com/2011-dress-like-the-celebrities-kim-kardashian>.

Or imagine that a young man in London is spotted on the street wearing an army green jacket by a blog that documents fashion.<sup>58</sup> This man could inspire others to wear such jackets, and eventually, designers add the military-inspired looks into their Fall collections. Malcolm Gladwell, in his book *The Tipping Point*, notes how the Hush Puppies trend started from the bottom up. The trend began with a few New York hipsters, and eventually swept the entire industry, lasting for years.<sup>59</sup>

More traditionally, a trend begins with the designer. Dresses at the Academy Awards often create new trends. The dresses at this year's Oscars have already created buzz online about a new color trend, including forecasts that either purple or red will be taking over fashion: "At last year's Oscars it was white . . . this year's Golden Globe awards we saw a huge range of celebrities in green . . . [and] tonight one look that really stood out was the red dress."<sup>60</sup> Others noted the prominence of purple at Oscars 2011.<sup>61</sup> Ten years ago, a costume designer for the HBO program *Sex and the City* once put Sarah Jessica Parker's lead character into a dress with an oversized flower as an accessory. This became the trend for the season, and high-end designers, as well as Ann Taylor and Wal-Mart, started selling dresses, t-shirts, and other items decorated with oversized flowers.<sup>62</sup>

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<sup>58</sup> *Right Now in the Streets of London*, STREETPEEPER.COM (Feb. 8, 2011), <http://streetpeeper.com/fashion/jason-farrer-smiling>.

<sup>59</sup> See generally MALCOLM GLADWELL, *THE TIPPING POINT* 1–2 (2002).

<sup>60</sup> *Oscar 2011 Red Carpet Fashion Trends: The Red Dress*, SHINYSTYLE.COM (Feb. 27, 2011), <http://www.shinystyle.tv/2011/02/oscar-2011-red-carpet-fashion-trends-the-red-dress.html>.

<sup>61</sup> *Oscar 2011 Dress Trend: Purple Gowns*, FASHIONETC.COM (Feb. 27, 2011), <http://fashionetc.com/news/fashion/831-oscars-2011-dresses-purple-natalie-portman>.

<sup>62</sup> Nicole Giambarrese, *Intellectual Property Comment: The Look for Less: A Survey of Intellectual Property Protections in the Fashion Industry*, 26 *TOURO L. REV.* 243, 243–244 (2010) ("‘Sex and the City’ debuted as an original series broadcasted by the Home Box Office on June 6, 1998. The series brought designer fashion and couture into the homes of millions of women, across a vast age range, who all wished that they could afford the Chanel purses and Christian Louboutin shoes worn by the characters. Filming in the Mecca of fashion, New York City, viewers were exposed to the upscale boutiques on Fifth Avenue, and an endless parade of couture, designer dresses, handbags, and jewelry. As a

Trends are influenced by a variety of factors, but clearly, those who are able to ride the trend are able to profit from it. Part III will further explore trends and how academics have theorized that due to the strong trend cycle in fashion, stronger intellectual property rights in the fashion world should not be encouraged.<sup>63</sup>

E. *Knocking Off in the Digital Age*

High-end fashion designers can take up to twenty-four months to bring a design from a sketch to the manufacturing room.<sup>64</sup> From the time that a high-end design debuts on the runway, it could take another four months for the product to reach a retail store.<sup>65</sup> One season for a fashion design will usually last from three to six months and can cost millions of dollars.<sup>66</sup> In contrast, copying designers and manufacturers “inspired” by high-end designs take as little as four to six weeks to get their products into the marketplace. For instance, as noted above, Golden Globes and Oscar gowns are often knocked off almost as soon as they hit the red carpet, while the authentic designer will take months to create the product in the first place.<sup>67</sup> This year, the Oscars took place on

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consequence of digital media, these designs were readily imitated and instantaneously reproduced by other designers for discount stores, such as Forever 21. Additionally, pirates copied these designs and sold the knockoffs and counterfeit products about a mile south of the upscale shopping on Fifth Avenue: Canal Street.”).

<sup>63</sup> See *infra* Part III.

<sup>64</sup> Laura C. Marshall, *Catwalk Copycats: Why Congress Should Adopt a Modified Version of the Design Piracy Prohibition Act*, 14 J. INTELL. PROP. L. 305, 311 (2007).

<sup>65</sup> Howard, *supra* note 49, at 343; *id.* at 328–29 (“Fashion houses, such as Prada and Marc Jacobs, display their seasonal collections on runways in New York City, London, Milan, and Paris, approximately six months before the designs will appear on the market (i.e., designs for the upcoming fall are shown in February and March)”).

<sup>66</sup> Emily S. Day, *Double-Edged Scissor: Legal Protection for Fashion Design*, 86 N.C.L. REV. 237, 252 (2007).

<sup>67</sup> *Id.*; see also Hemphill, *supra* note 54; Molly Tully, *Oscar Gown Knockoffs are Out!*, NEWJERSEYBRIDE.COM (Mar. 12, 2010, 10:01 AM), <http://www.newjerseybride.com/blogs/editor-mollys-blog/oscar-gown-knockoffs-are-out>.

February 27, 2011,<sup>68</sup> and immediately, web sites started advertising Oscar knockoffs to eager buyers. An article posted on March 1, 2011 noted that Faviana, well-known for knocking off Oscar dresses to sell as prom and wedding gowns, makes samples of Oscar dresses by 8 a.m. the day after the Oscar ceremony, with a prediction that the knockoff dresses will hit the market in eight to ten weeks. According to Faviana, “[w]e take all the trends and make a dress for each one.” Faviana reports that some dresses, like Eva Longoria's black dress, is more a “woman’s dress” while others are more “prom.”<sup>69</sup> The designers also take into account color trends that they believe will be the “it” colors for the season—this year, for example, red and purple—in order to create an entire line of knockoffs.<sup>70</sup> This year, Oscar knockoffs made it out even faster than the projected timelines, and web sites celebrated the ability to get the knockoffs from Faviana and A.B.S. by March 12, 2011, a mere fourteen days after the Oscar ceremony revealed the dresses. In fact, other articles note that the process is even quicker, with knockoff designers feeling pressure to get their top Oscar dress picks out to manufacturers by 5:30 am and for the dresses to be available on the market within a week.<sup>71</sup>

Technology has only accelerated the ability of knockoff designers to view designs and reproduce them.<sup>72</sup> Today, high-end

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<sup>68</sup> *Oscar Predictions*, MOVIEFONE.COM, <http://www.moviefone.com/oscars-academy-awards/features/oscar-predictions> (last visited Mar. 16, 2011).

<sup>69</sup> Sara Lolley, *Winning Looks for Less*, PITTSBURG POST GAZETTE (Mar. 1, 2011), <http://www.post-gazette.com/pg/11060/1128705-314.stm>.

<sup>70</sup> *Id.*

<sup>71</sup> Tully, *supra* note 67; John Harlow, *2010 Oscars: Copycat Dresses On Sale Within a Week*, THE SUNDAY TIMES (Mar. 7, 2010), [http://entertainment.timesonline.co.uk/tol/arts\\_and\\_entertainment/film/oscars/article7052414.ece](http://entertainment.timesonline.co.uk/tol/arts_and_entertainment/film/oscars/article7052414.ece).

<sup>72</sup> Hemphill, *supra* note 54, at 1171. (“What has changed is not the fact or speed of copying, but the large scale and low cost at which rapid copies can be made. (For comparison, just think of music, where rapid copying has long been feasible, while large-scale, low-cost rapid copying is a new phenomenon.”). Today, a pattern can be based upon an Internet broadcast of the runway show and transmitted electronically to a low-cost contract manufacturer overseas. A gradual easing in import quotas, begun in 1995, has increased scale and thereby lowered overseas manufacturing costs. Electronic communications and express shipping ensure that prototypes and finished articles can be brought to market



designs from runway shows become available on the Internet as a matter of practice within twenty-four hours.<sup>73</sup> Web sites like style.com display photographs of high-end designs. These photographs allow other designers to view the designs in detail from various angles, including close-up photographs of a design's details and accessories which are supplemented by editorial assessments of the design.<sup>74</sup> The knockoff companies can then tell manufacturers which designs to lift off the runway for mass production, without even traveling to the runway shows.

Moreover, e-mail technology has increased the speed of worldwide apparel production in general giving knockoff artists another advantage in getting stolen designs out to the market with greater speed and agility. For example, a knockoff designer can email the knockoff designs (along with a link to the photographs of the original) to the overseas manufacturer and tell them to start manufacturing the knockoff immediately.<sup>75</sup> Renowned high-end designer Diane von Furstenberg, president of the Council of Fashion Designers in America ("CFDA") noted how this creation of fast copies creates a weakness for emerging designers in the fashion industry and not just high-end designers:

In legal terms, fashion designers are the poor relations of the creative world. Starving artists, struggling writers and independent filmmakers all at least own the rights to their work. Emerging designers, however, remain vulnerable to knockoff artists who can steal ideas straight off the runway and produce copies before the originals even reach stores. This can effectively put young designers out of business before they even have a chance.<sup>76</sup>

Prior to the Internet and email, high-end designers enjoyed a greater lead time, as knockoffs required more time to produce, and designers often could rest assured that their ideas would not be

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quickly. As a result, thousands of inexpensive copies of a new design can be produced, from start to finish, in six weeks or less.").

<sup>73</sup> Howard, *supra* note 49, at 343; *see, e.g.*, Alison Baenen, *Charlotte Ronson*, STYLE.COM (Feb. 12, 2011), <http://www.style.com/fashionshows/review/F2011RTW-CRONSON>.

<sup>74</sup> *Id.*; *Trend Reports*, STYLE.COM, <http://www.style.com/trendsshopping/trendreport> (last visited Mar. 17, 2011).

<sup>75</sup> Von Furstenberg, *supra* note 6.

<sup>76</sup> *Id.*

copied into another designer's collection for at least six months if not up to a year.<sup>77</sup> In the past, the high-end designer would have a window of time in which to attract trendsetters wishing to be the first to wear a design. Today, those trendsetters, who once might have waited, may now purchase the lower-end knockoff before the higher-end original even hits the retail market.

The combination of new technologies with traditional forms of media furthers the ability of the knockoff industry to thrive. When reading *InStyle* magazine, one can find sections on how to replicate high-end trends for reasonable prices.<sup>78</sup> In the Accessories section, *InStyle* displays a section entitled "As Seen On The Runway" showing the runway scarf by Adrienne Landau for \$125 next to an affordable faux fur scarf from H&M for a mere \$15.<sup>79</sup> H&M, TopShop, and Zara are strongholds in the industry which fashion magazines often present as alternatives for high-end original items. Instyle.com will offer similar daily fashion comparisons and cheaper fashion item recommendations.<sup>80</sup>

Perhaps the most surprising threat to original designers is the reputable retailer whose average customers might be unwilling to go cheap but who are unwittingly buying knockoff designs. For example, Macy's has been known to sell both a design's original and its knockoff in different price ranges.<sup>81</sup> Other retailers carry "house brands" which are often knockoff designs created through the inspiration of copying runway designs.<sup>82</sup> The allure of brand named designs and high-quality goods likely will still hold a particular set of clientele, but there is a group of fashionistas<sup>83</sup> and aspiring fashionistas who are likely to be more pragmatic and less patient when it comes to buying a trendy outfit. A pragmatic

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<sup>77</sup> Howard, *supra* note 49 at 341; see also Hemphill, *supra* note 54 at 1196.

<sup>78</sup> *Shot It! Deals & Steals: Get Gorgeous Fast*, IN STYLE, Oct. 2010, at 348.

<sup>79</sup> *Id.* at 332.

<sup>80</sup> *Look of the Day*, INSTYLE.COM (Jan. 27, 2008), <http://www.instyle.com/instyle/celebrities/lookoftheday/photos/0,20173878,00.html>.

<sup>81</sup> Howard, *supra* note 49, at 343.

<sup>82</sup> *Id.* at 344.

<sup>83</sup> *Fashionista Definition*, OXFORDADVANCEDLEARNERSDICTIONARY.COM, <http://www.oxfordadvancedlearnersdictionary.com/dictionary/fashionista> (last visited Mar. 17, 2011) ("(used especially in newspapers) . . . a fashion designer, or a person who is always dressed in a fashionable way").

approach would be to ask, why wait for the \$2,000 dress from Michael Kors when there is a version already out for \$300? In the digital age, designers not only face the threat of knockoffs, but need to confront the possibility that the knockoffs are likely to hit the market well before their original work.

### III. THE NEED FOR INTELLECTUAL PROPERTY IN FASHION

As shown earlier in this article, fashion is a large, profitable business and for high-end designers as well as emerging designers, the threat of knockoffs is an increasingly challenging issue in the digital age. This leads to the inevitable question: should a designer take steps to protect her work, and what options are available to her in terms of intellectual property protection?

Some scholars contend that the fashion industry in the United States relies upon weak intellectual property protection to support fast trends and increased productivity and creativity from designers.<sup>84</sup> As a threshold issue, it is important to note that many legal scholars do not believe fashion designers, even high-end ones, benefit in the long run from strong intellectual property protections for fashion.<sup>85</sup> Some warn that strong intellectual property protections will kill the trend cycle and reduce the price that the public will pay for high-end designs, while simultaneously hurting the consumers. Some argue that fashion benefits from the cycle of trends that is inherently the result of copying.<sup>86</sup> First, they point out that the fashion industry has a long history of copying which has become an acceptable part of the fashion culture.<sup>87</sup> Notably, they point to the lack of attention and relatively low number of lawsuits involving knockoff designers as illustrating a tacit

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<sup>84</sup> Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687 (2006).

<sup>85</sup> James Surowiecki, *The Piracy Paradox*, THE NEW YORKER (Sep. 24, 2007), [http://www.newyorker.com/talk/financial/2007/09/24/070924ta\\_talk\\_surowiecki](http://www.newyorker.com/talk/financial/2007/09/24/070924ta_talk_surowiecki).

<sup>86</sup> Raustiala & Sprigman, *supra* note 55.

<sup>87</sup> Raustiala & Sprigman, *supra* note 84, at 1716 (quoting Tom Ford, former managing designer of Gucci: "appropriation and sampling in every [fashion] field has been rampant.").

acceptance of the knockoff industry by the high-end fashion designers.<sup>88</sup>

The argument continues that handcuffing the trend cycle with stronger intellectual property protection will eventually kill innovation in fashion altogether.<sup>89</sup> The public's need for high fashion is not driven by a need for the actual garment, but rather the status conveyed by the garment. As a look becomes more common through knockoffs, the high-end fashion designers are incentivized to innovate with a new design that recaptures the lost status.<sup>90</sup> Furthermore, "innovation" in the fashion world is inherently built on originators who become copyists at some point in their career. Thus, if every designer will copy at some point in their career, then they have no right to protest against the general act of copying.<sup>91</sup> Finally, these scholars argue that stronger intellectual property protections would also hurt the consumers who benefit enormously from the knockoff industry.<sup>92</sup> As a result of knockoffs, the current styles are not restricted to the wealthy, which plays "a major role in democratizing fashion."<sup>93</sup>

This failure to take advantage of the existing intellectual property protections, however, likely harms emerging fashion designers.<sup>94</sup> If there is an endless cycle of trends based on copying that is buttressed by weak intellectual property protections, then this cycle may be at the expense of up-and-coming fashion designers.<sup>95</sup> But, the failure to use the existing intellectual property protection seems to be harming those designers who have yet to make a name for themselves in the industry.<sup>96</sup> Some scholars agree that these emerging artists are at the greatest risk of being

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<sup>88</sup> *Id.*

<sup>89</sup> Raustiala & Sprigman, *supra* note 55.

<sup>90</sup> *Fashion Copyrights Cut Creativity*, LA TIMES (Aug. 15, 2007), <http://www.latimes.com/news/opinion/editorials/la-ed-fashion15aug15,0,5421470.story?coll=la-news-comment-editorials>.

<sup>91</sup> Raustiala & Sprigman, *supra* note 84 at 1728.

<sup>92</sup> See Raustiala & Sprigman, *supra* note 55.

<sup>93</sup> *Id.*

<sup>94</sup> Binkley, *supra* note 26.

<sup>95</sup> *Id.*

<sup>96</sup> Von Furstenberg, *supra* note 6.

vulnerable to the harm of copyists.<sup>97</sup> If customers do not recognize the brand, they may not be aware that they are buying a knockoff of a new or smaller designer. Thus, these new or smaller designers appear to bear the brunt of the knockoff industry, and would likely benefit the most from protecting their designs.<sup>98</sup>

In practice, the best solution would be to support stronger intellectual property protections that combat the harm from “close copying”<sup>99</sup> but still allow for free association and the ability for designers to share ideas to innovate. “Our distinctive goal is to prohibit close copies while preserving flocking and differentiation in its varied forms of inspiration, homage, referencing, and quotation. The guiding principle throughout is to avoid the hypertrophy or thicket of rights that is threatened by excessive, multiple rights holders.”<sup>100</sup> In order to protect designers from the knockoff industry in all its forms, intellectual property protections are necessary, but as will be shown in the parts below, copyright law alone offers limited protection to fashion designers. Thus, designers should consider alternative methods of legal protection.

#### IV. INTELLECTUAL PROPERTY OPTIONS TO PROTECT FASHION DESIGNS

Today, unlike in parts of Europe, designers in the United States do not have *sui generis* protection for fashion designers. Some scholars even argue that in the United States, copying of a fashion designer’s work is completely legal and to many, an acceptable practice.<sup>101</sup> Early attempts at protecting fashion design were struck down by the U.S. Supreme Court. And that more recent attempts

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<sup>97</sup> Binkley, *supra* note 26 (“Small designers face a particularly large burden; often, they lack deep pockets to chase down versions they find similar, and their brands are so little-known that customers often aren’t aware they’re not buying an original design.”); Stephanie Clifford, *In a Downturn, Even Knockoffs Go Downscale*, N.Y. Times, Aug. 1, 2010, at A1 (N.Y. ed.), available at <http://www.nytimes.com/2010/08/01/business/economy/01knockoff.html>.

<sup>98</sup> Binkley, *supra* note 26.

<sup>99</sup> Hemphill, *supra* note 54, at 1153 (distinguishing “close copying” from “participation in common trends”).

<sup>100</sup> *Id.* at 1184.

<sup>101</sup> Raustiala & Sprigman, *supra* note 55.

to modify the Copyright Act have also met with resistance. But, many forms of general intellectual property protection are available to fashion designers including: copyright, trade dress, trademark, unfair competition, theft of trade secrets, as well as design patents. However none of these protections are specifically tailored to fashion design. Thus, fashion designers in search of intellectual property protection are left with a small web of existing intellectual property protection tools to protect their work.

*A. History of Fashion's Intellectual Property Protection*

Protecting original fashion designs from knockoff designers is not a new problem. In 1933, garment designers banded together to create the Fashion Originators Guild of America ("the Guild") in cooperation with retailers.<sup>102</sup> The Guild was founded by Maurice Rentner, who some have called the prince of American ready-to-wear.<sup>103</sup> Rentner's daydresses and suits had uncomplicated silhouettes and thus, he found his work was often the victim of piracy.<sup>104</sup> The Guild grew from twelve to sixty members by the end of its first year.<sup>105</sup> Members of the Guild pledged only to sell original creations, which were registered with the Guild and bore a label stating their exclusivity.<sup>106</sup> If a retailer did not follow the rules of the Guild, then they would be issued a "red card" thereby forbidding the other Guild-member manufacturers from selling to the offending retailer.<sup>107</sup> Ultimately, the Guild was dismantled by the Supreme Court in 1941 for violating the Sherman Antitrust Act.<sup>108</sup> After this decision, Rentner lobbied Congress to provide copyright protection for fashion, but many in the industry were

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<sup>102</sup> Pastperfectvintage.com, *Fashion Originators Guild*, VINTAGE FASHION GUILD, <http://vintagefashionguild.org/label-resource/fashion-originators-guild/> (last visited Mar. 19, 2011).

<sup>103</sup> Madelyn Shaw, *Maurice Rentner*, in CONTEMPORARY FASHION 564–65 (Taryn Benbow-Pfalzgraf ed., 2nd ed. 2002).

<sup>104</sup> *Id.*

<sup>105</sup> "Rentner, Maurice," ENCYCLOPEDIA.COM, <http://www.encyclopedia.com/doc/1G2-3401400352.html> (last visited Mar. 26, 2011).

<sup>106</sup> Pastperfectvintage.com, *supra* note 102.

<sup>107</sup> *Id.*

<sup>108</sup> *Fashion Originators Guild of Am. v. F.T.C.*, 312 U.S. 457 (1941).

opposed to such protection, and his efforts to influence Congress died.<sup>109</sup>

#### B. *The Existing Copyright Statute Fails Fashion*

Many individuals unfamiliar with the fashion industry and intellectual property assume that copyright protections exist for fashion designs just as they do for music and other creative industries. However, U.S. law generally views fashion designs as “useful articles” not generally granted copyright protection.<sup>110</sup> Nonetheless, copyrights remain valuable tools to protect fabric designs and the individual patterns for each garment, much like any illustration.<sup>111</sup> For instance, fashion designer Diane Von Furstenberg recently began copyrighting fabric patterns, and in 2008, she sued Target for allegedly copying her “spotted frog” print.<sup>112</sup> In response, Target quickly stopped selling the dresses using that fabric and promised to work with the vendor to resolve the issue.<sup>113</sup> But even there, only Ms. Furstenberg’s fabric design was protected, not the overall fashion design of her work.

<sup>109</sup> Raustiala & Sprigman, *supra* note 55; *Friend Friday: Copying in the Fashion Industry (is imitation the sincerest form of flattery?)*, BEAUTIFULLY INVISIBLE (Sept. 3, 2010), <http://www.beautifully-invisible.com/2010/09/friend-friday-copying-in-fashion.html>.

<sup>110</sup> This analysis is beyond the scope of this paper. See generally Richard G. Frenkel, *Intellectual Property in the Balance: Proposals for Improving Industrial Design Protection in the Post-TRIPS Era*, 32 LOY. L.A. L. REV. 531, 541 (1999).

<sup>111</sup> Jennifer Mencken, *A Design for the Copyright of Fashion*, 1997 B.C. INTELL. PROP. & TECH. F. 4, at 10 (“Fabric designs are deemed to be consistent with the similarly copyrightable expressions of paintings and other pictorial or graphic materials.”), available at [http://www.bc.edu/bc\\_org/avp/law/st\\_org/ip/f/articles/content/1997121201.html](http://www.bc.edu/bc_org/avp/law/st_org/ip/f/articles/content/1997121201.html); See also *FL-109: Copyright Registration of Books, Manuscripts, and Speeches*, U.S. COPYRIGHT OFFICE, <http://www.copyright.gov/fls/fl109.html> (allowing protection for other forms of creative arts) (last updated Jan. 2011).

<sup>112</sup> Complaint, *Diane von Furstenberg Studio, L.P. v. Target Brands, Inc.*, No. 1:08-cv-00866-CM (S.D.N.Y. Jan. 24, 2008), Doc. 1, available at [http://www.lexisnexis.com/documents/pdf/20080603025139\\_large.pdf](http://www.lexisnexis.com/documents/pdf/20080603025139_large.pdf); see also Reena Jana, *Put a Patent on that Pleat*, BLOOMBERG BUSINESSWEEK (Mar. 20, 2008, 5:00 PM), [http://www.businessweek.com/magazine/content/08\\_13/b4077065407184\\_page\\_2.htm](http://www.businessweek.com/magazine/content/08_13/b4077065407184_page_2.htm).

<sup>113</sup> Jana, *supra* note 112.

C. *Proposed Amendments to the Copyright Act to Protect Fashion Designs*

Because copyright does not currently protect the overall fashion design, some members of Congress have tried, but have not yet succeeded, in passing legislation amending the Copyright Act to specifically protect fashion designs. Below, the most recent attempts will be outlined.

1. *Design Piracy Prohibition Act*

Introduced in 2007, the Design Piracy Prohibition Act (“DPPA”) would have amended the Title 17 of the United States Code—the Copyright Act—to include fashion design.<sup>114</sup> The DPPA would provide a sui generis copyright protection for fashion designs for three years.<sup>115</sup> The designer would be required to register the design with the Copyright Office within three months of making the design public.<sup>116</sup> In other words, to benefit from this protection, the designer would likely need to register the design within three months of the first runway show or publication of advertisements depicting the design, depending upon how this statute is later interpreted by the courts. Infringing conduct under the proposed act would include making, having made, importing, selling, or distributing any article embodying a design unless done without knowledge or reasonable grounds to know that protection for the design is claimed.<sup>117</sup> The Act would adopt an original and not closely and substantially similar in overall visual appearance standard in determining copyright infringement.<sup>118</sup>

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<sup>114</sup> S. 1957, 110th Cong. (2007), available at <http://www.gpo.gov/fdsys/pkg/BILLS-110s1957is/pdf/BILLS-110s1957is.pdf>.

<sup>115</sup> *Id.* § 2; see also *Bill Summary & Status 110<sup>th</sup>- Congress (2007-2008) – S. 1957 CRS Summary*, THOMAS (Library of Congress) (Aug. 2, 2007), <http://thomas.loc.gov/home/LegislativeData.php?&n=BSS&c=110> (choose “Bill Number” from the dropdown menu, type “S. 1957” in the search box, click “Search,” select “CRS Summary” link) (last visited Apr. 12, 2011).

<sup>116</sup> S. 1957 §2.

<sup>117</sup> *Id.*

<sup>118</sup> *Bill Summary & Status*, *supra* note 115.



Some commentators have noted that the bill faces much opposition both from industry insiders and outsiders.<sup>119</sup> Within the fashion industry, the CFDA and the American Apparel and Footwear Association (“AAFA”) disagreed on many of the substantive aspects of the DPPA.<sup>120</sup> The AAFA never gave its full and unwavering support to the bill.<sup>121</sup> The CFDA believed that the DPPA could afford established and up-and-coming designers the protection needed to cultivate the art of fashion design, while the AAFA felt that the DPPA would result in the hampering of creativity and an increase in frivolous lawsuits.<sup>122</sup>

## 2. *Innovative Design Protection and Piracy Prevention Act*

Another, more recent effort, the Innovative Design Protection and Piracy Prevention Act (“IDPPPA”)<sup>123</sup> has made headlines.<sup>124</sup>

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<sup>119</sup> See Anya Jenkins Ferris, *Real Art Calls for Real Legislation: An Argument Against Adoption of the Design Piracy Prohibition Act*, 26 CARDOZO ARTS & ENT. L.J. 559, 561 (2008).

<sup>120</sup> Ronald Urbach & Jennifer Sousa, *Is the Design Piracy Protection Act A Step Forward For Copyright Law Or Is It Destined To Fall Apart At The Seams*, METRO. CORP. COUNS., July 2008 at 28, 28 (citing AAFA as opposing the DPPA), available at <http://www.metrocorpcounsel.com/current.php?artType=view&artMonth=March&artYear=2011&EntryNo=8525>.

<sup>121</sup> *Id.*

<sup>122</sup> Michael Miller, *The Deepening Divide Over Fashion’s Intellectual Property*, J.C. REPORT (Aug. 7, 2009), <http://jcreport.com/rss/tag/dppa/>.

<sup>123</sup> S. 3728, 111th Cong. (2010), available at <http://www.gpo.gov/fdsys/pkg/BILLS-111s3728rs/pdf/BILLS-111s3728rs.pdf>.

<sup>124</sup> See e.g., Staci Riordan, *Why IDPPPA Is Going to KO the Business of Fashion*, FASHION LAW BLOG (Aug. 30, 2010), <http://fashionlaw.foxrothschild.com/2010/08/articles/design-piracy-prohibition-act/why-idpppa-is-going-to-ko-the-business-of-fashion/>; Kathleen Fasanella, *IDPPPA: Yet Another Fashion Design Copyright Law*, FASHION-INCUBATOR (Aug. 6, 2010, 7:09 AM), <http://www.fashion-incubator.com/archive/idpppa-yet-another-fashion-design-copyright-law/>; Biana Borukhovich, *IDPPPA: The Copyright Compromise*, NYSBA.COM (Sept. 9, 2010, 11:40 AM), [http://nysbar.com/blogs/EASL/2010/09/idpppa\\_the\\_copyright\\_compromis.html](http://nysbar.com/blogs/EASL/2010/09/idpppa_the_copyright_compromis.html); Jeanne DiGrazio, *Extending Copyright Protection to Fashion Design: The “Innovative Design Protection and Piracy Prevention Act,”* BACON THOMAS (Dec. 18, 2010), <http://www.baconthomas.com/wordpress/?p=250>; Nik, *Fashion Law: McQueen Sued & IDPPPA, S.3728*, THREAD CONSCIOUS (Dec. 6, 2010, 3:43 PM), <http://threadconscious.com/blog/2010/12/fashion-law-mcqueen-sued-idpppa-s-3728/>.

The proposal for the IDPPPA aimed once again to change Title 17 of the United States Code so that fashion design would be included under the protections of copyright law. On December 1, 2010, the IDPPPA passed through the Senate Judiciary Committee with a unanimous vote.<sup>125</sup> Unlike other recent bills, the IDPPPA had the backing of the CFDA and the AAFA,<sup>126</sup> the two organizations that were at odds over the DPPA.<sup>127</sup>

The IDPPPA would have no registration period during which designers would have to apply for copyright protection, but a would-be plaintiff would have to plead facts in their complaint with particularity—a much higher standard than under the DPPA.<sup>128</sup> This higher pleading standard requires the plaintiff to plead that the initial design was original, that the knockoff design is “substantially identical” and the knockoff manufacturer had an opportunity to see the original design before it was publicly released.<sup>129</sup> Additionally, the IDPPPA would require designers to prove that their designs are a “non-trivial” variation, among other

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<sup>125</sup> Staci Riordan, *Senator Feinstein Puts the Breaks on the “Destruction of Affordable Fashion Bill,”* FASHION LAW BLOG (Dec. 23, 2010), <http://fashionlaw.foxrothschild.com/2010/12/articles/design-piracy-prohibition-act/senator-feinstein-puts-the-breaks-on-the-destruction-of-affordable-fashion-bill/>; *Bill Summary & Status -111th Congress (2009 - 2010) - S.3728 - All Information*, THOMAS (LIBRARY OF CONGRESS), <http://thomas.loc.gov/home/LegislativeData.php?&n=BSS&c=111> (Search for “Bill Number” S3728 in the “Enter Search” bar; then follow “All Information” hyperlink) (last visited Mar. 22, 2011).

<sup>126</sup> Susan Scafidi, *IDPPPA: Introducing the Innovative Design Protection and Piracy Protection Act, a.k.a. Fashion Copyright*, COUNTERFEIT CHIC (Aug. 6, 2010), <http://www.counterfeitichic.com/2010/08/introducing-the-innovative-design-protection-and-piracy-prevention-act.html>.

<sup>127</sup> Urbach & Sousa, *supra* note 120; Cherie Yang, *The IDPPPA—Is the Third Time a Charm?*, COLUM. BUS. L. REV. (Nov. 7, 2010), <http://cblr.columbia.edu/archives/11357>.

<sup>128</sup> See *IDPPPA: Design Piracy Gets Another Makeover*, LOAH: LAW OFFICES OF ASTRIDE HOWELL (Oct. 12, 2010), <http://www.loah.com/newsite/fashiondesign/idpppa-design-piracy-get-another-makeover/>; Yang, *supra* note 127.

<sup>129</sup> Yang, *supra* note 127.

requirements, from previous designs.<sup>130</sup> Finally, the protection would last for only three years.<sup>131</sup>

While the IDPPPA has made it through the Senate Judiciary Committee, it remains highly controversial.<sup>132</sup> Some view it as a savior for intellectual property rights in the fashion industry while others see the dire consequences of having actual fashion copyright protection available.<sup>133</sup> Some complain that if enacted, the IDPPPA would produce frivolous lawsuits because it does not require designers to register.<sup>134</sup> Others argue that the high standard created by the “substantially identical” and “non-trivial” standards will render the IDPPPA ineffective.<sup>135</sup> However, at least some think that the IDPPPA “provides clarity to help prevent knockoffs and protect [high-end] fashion.”<sup>136</sup>

Until the IDPPPA or the DPPA is enacted, copyright cannot be said to adequately protect fashion designs.

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<sup>130</sup> *Id.*; Innovative Design Protection and Piracy Prevention Act, S. 3728, 111<sup>th</sup> Cong. (2010) available at [http://www.counterfeitchic.com/Documents/IDPPPA\\_as\\_introduced\\_8-5-10.pdf](http://www.counterfeitchic.com/Documents/IDPPPA_as_introduced_8-5-10.pdf).

<sup>131</sup> Janet Kim Lin, *Alterations to the Design Piracy Prohibition Act*, BULLIVANT HOUSER BAILEY (Aug. 2010), <http://www.bullivant.com/Alterations-to-Design-Piracy-Prohibition-Act>.

<sup>132</sup> See Susan Scafidi, *IDPPA: Introducing the Innovative Design Protection and Piracy Prevention Act, a.k.a. Fashion Copyright*, COUNTERFEIT CHIC (Aug. 6, 2010), <http://www.counterfeitchic.com/2010/08/introducing-the-innovative-design-protection-and-piracy-prevention-act.html> (supporting the proposal that the Act remains controversial); Udaak Law Firm, *Senate Judiciary Committee Passes Fashion Copyright Bill #IDPPPA* UDUAK LAW FIRM (Dec. 7, 2010), <http://fashionentlaw.com/fashion-law/senate-judiciary-committee-passes-fashion-copyright-bill-idpppa/>; Staci Riordan, *The “Destruction of Affordable Fashion Bill” or IDPPPA Gets One Step Closer to Becoming Fashion Law*, FASHION LAW BLOG, (Dec. 2, 2010), <http://fashionlaw.foxrothschild.com/tags/idpppa/> (disapproving of the proposal); Riordan, *supra* note 124 (disapproving of the proposal).

<sup>133</sup> Nik, *supra* note 124.

<sup>134</sup> *Id.*

<sup>135</sup> *Id.*; see also Oren Gelber, *Should Fashion be Protected by Copyright?*, COPYRIGHT CHRONICLE, (Sept. 17, 2010), <http://copyrightchronicle.blogspot.com/2010/09/should-fashion-be-protected-by.html>.

<sup>136</sup> Watkins, *supra* note 13, at 55.

#### D. *Trademark and Trade Dress Offers Limited Protection*

Like copyright, trademark and trade dress are not ideal for protecting fashion designs. Trademark protection may cover the designer's logo or name, but that protection is not broad enough to protect the fashion design. In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*,<sup>137</sup> the Supreme Court held that trademark protection does not extend to the clothing design itself.<sup>138</sup> Furthermore, trade dress protects the visual appearance of product, but requires time in the marketplace to develop distinctiveness through secondary meaning.<sup>139</sup> In other words, trade dress only protects clothing if the clothing has acquired recognition among consumers as being associated with a particular brand.<sup>140</sup> Most new designers have not been in the marketplace long enough to develop trade dress rights to protect their up-and-coming designs.

Thus, although copyright provides limited protection, trademark and trade dress also provide some protection for aspects of fashion design, copyright protection for fashion design is far from comprehensive, and additional forms of protection should be considered. Design patents, though under-utilized, provide one way to protect certain types of fashion design which would otherwise be unprotected.

#### V. DESIGN PATENTS: A VIABLE ALTERNATIVE FOR ORIGINAL FASHION

Unlike copyrights and trademarks, the appearance of "useful articles" may be granted protection under U.S. patent law. As a type of U.S. industrial design right, a design patent generally applies to how something looks without regard to how it functions.<sup>141</sup> While some academics may discount their value, design patents have been used to provide protection for products of

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<sup>137</sup> 529 U.S. 205 (2000).

<sup>138</sup> *Id.* at 216.

<sup>139</sup> *Id.*

<sup>140</sup> Watkins, *supra* note 13 at 55; *Wal-Mart*, 529 U.S. at 211.

<sup>141</sup> U.S. PATENT AND TRADEMARK OFFICE, Manual of Patent Examining Procedure (M.P.E.P.) § 1502.01, Revision 5, Aug. 2006, available at [http://www.uspto.gov/web/offices/pac/mpep/mpep\\_e8r5\\_1500.pdf](http://www.uspto.gov/web/offices/pac/mpep/mpep_e8r5_1500.pdf).

the fashion industry, including shoes, handbags, belts, elements of outerwear, headgear, and eyeglass frames.<sup>142</sup>

In sum, no solution, short of *sui generis* protection, may completely protect fashion designs, but in the meantime, design patents offer a cost-effective solution to protect many facets of original fashion design and provide overlapping or supplemental protection with the other types of intellectual property protection outlined above.

A. *Design Patents Protect How an Article Looks, Not How It Functions*

Design patents provide legal protection to inventors of “new, original, and ornamental design for an article of manufacture.”<sup>143</sup> A design is “manifested in appearance” as “visual characteristics embodied in or applied to an article.”<sup>144</sup> In other words, a design patent protects the way an article looks.<sup>145</sup> The article of manufacture under consideration for a design patent must not be dictated primarily by its function,<sup>146</sup> and the design patent only protects the non-functional aspects of the article.<sup>147</sup> Design patents are generally limited to the shape of an article, the surface ornamentation of an article or the combination of the two.<sup>148</sup> Additionally, a design must be preconceived and capable of reproduction in order to be protected by a design patent.<sup>149</sup> In this

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<sup>142</sup> Julia Anne Matheson and Stephen L. Peterson, *Combine and Conquer: How the Synthesis of Design Patent and Trade Dress Achieve Maximum Protection for Your Product Design*, FINNEGAN (May 2009), <http://www.finnegan.com/resources/articles/articlesdetail.aspx?news=74f843bec63a-40cc-8ae0-007bc50fdd99>.

<sup>143</sup> 35 U.S.C. § 171 (2006); U.S. PATENT AND TRADEMARK OFFICE, *supra* note 141, § 1504.01.

<sup>144</sup> U.S. PATENT AND TRADEMARK OFFICE, *supra* note 141, § 1502.

<sup>145</sup> *Id.* § 1502.01 (noting as a point of contrast, how a utility patent protects the way an article is used and works).

<sup>146</sup> 35 U.S.C. § 171 (2006).

<sup>147</sup> See 37 CFR § 1.153 (2010) (describing the design patent application as only asking for a description of the ornamental design of the article).

<sup>148</sup> U.S. PATENT AND TRADEMARK OFFICE, *A Guide to Filing a Design Patent Application*, <http://www.uspto.gov/patents/resources/types/designapp.jsp#def> (last visited Apr. 12, 2011).

<sup>149</sup> U.S. PATENT AND TRADEMARK OFFICE, *supra* note 141, § 1502.

context, an “article of manufacture” can be any object that has ornamental aspects including automobiles and their parts, medical devices, tire treads, and even buildings. The owner of the design patent has the right to prevent others from importing, making, offering for sale, or selling products that infringe the claimed design for a period of fourteen years.<sup>150</sup>

A design patent is particularly well-suited for fashion as it protects the way an article looks as opposed to how it is used or how it works.<sup>151</sup> The claimed design may be a portion of the design, the entire design, or ornamentation applied to a design.<sup>152</sup> Thus, a designer may file multiple applications for different parts of a single article, providing flexible protection that can be applied to more than one product in the marketplace.

#### B. *Applying for a Design Patent*

To apply for a design patent, the applicant must file a patent application with the United States Patent and Trademark Office (“USPTO”) and pay the applicable fees. The applicant must ensure that the application is filed within one year of: the first printed publication depicting the design, the first offer to sell a product covered by the claimed design, or the first public use of a product embodied in the claimed design.<sup>153</sup>

A design patent application contains only a single claim: “The ornamental design for a [*insert the type of product (e.g., handbag, belt buckle, hat)*], as shown and described.” The phrase “as shown and described” is a reference to the specification of the design patent which includes a description of each figure in the design patent. The descriptions are usually quite simple, such as “Figure 1 is a right front perspective view of my new design.” Thus, the scope of the claimed invention of a design patent is defined by the drawings or photographs that depict the design to be protected.

After the application has been filed, the USPTO will examine the application to determine if the design is ornamental (as

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<sup>150</sup> 35 U.S.C. § 173 (2006).

<sup>151</sup> 35 U.S.C. § 171 (2006).

<sup>152</sup> U.S. PATENT AND TRADEMARK OFFICE, *supra* note 148.

<sup>153</sup> 35 U.S.C. § 102(b) (2006).

opposed to functional), novel, and not obvious to a designer of ordinary skill in the art. The examiner will consider the “prior art” (designs that predate the design of the patent application) to evaluate if the design in the application is novel and not an obvious variant of the past designs.<sup>154</sup> The examiner will also determine if the drawings clearly and unambiguously depict and describe the design.<sup>155</sup> If the examiner rejects or objects to the application, the examiner will inform the applicant, who will be given an opportunity to respond and make certain changes to the figures. If the examiner finds the application complies with all the applicable criteria, then the application will be “allowed” and, provided the applicant meets other formalities, the USPTO will issue a design patent.

On average, the USPTO issues a design patent under the regular examination procedure in about fifteen months.<sup>156</sup> But the regulations allow for an expedited procedure in which a design patent is issued in an average of only five months.<sup>157</sup> This procedure requires that the applicant pay an additional fee, as well as conduct a pre-examination search of the prior art. Furthermore, the applicant must comply with shorter deadlines to respond to requests from the examiner. Finally, if the applicant fails to follow the special procedures, then her application must wait its turn along with the non-expedited applications.

During the period when a design patent application is pending, the applicant may choose to “mark” the products “patent pending” on the product itself or on the sales tag affixed to the product. There is no protection afforded by “patent pending.” Only after the patent issues may the patentee sue to enforce his patent rights.<sup>158</sup> The “patent pending” merely deters possible copyists that

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<sup>154</sup> 35 U.S.C. §§ 102–03 (2006).

<sup>155</sup> 35 U.S.C. § 112 (2006).

<sup>156</sup> Philippe J.C. Signore, *Expedited Examination of a Design Patent Application*, OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, L.L.P., <http://www.oblon.com/blog/donna/2010/04/12/expedited-examination-design-patent-application> (last visited Apr. 12, 2011).

<sup>157</sup> *Id.*

<sup>158</sup> *Id.*

a patent may issue in the future, so investment of time and capital in the copy may not be profitable.

In general, most practitioners do not consider it difficult to acquire a design patent. Indeed, most practitioners consider it much more like a registration process than a true examination process. In 2009, of the 485,500 design patent applications that were filed, the USPTO granted more than eighty percent of the applications without a single rejection.<sup>159</sup> The examination process focuses primarily on the clarity of the drawings or photographs, rather than on the relationship of the design to the “prior art.” Furthermore, a well-drafted design patent can be issued within one year of filing, even within months, if the patentee uses the procedure available for expedited handling.<sup>160</sup> But as explained in the next part, a design patent is only as strong as its figures.

### C. *Strong Design Patents Rely on Well-Conceived Figures*

The “figures” of a design patent are the drawings or photographs that depict the design and are the foundation for a strong design patent. The contents of the figures require careful thought and depict the basic design, not just the product the designer plans to sell.

#### 1. *Claim the Design, Not the Product as Sold*

First, generally speaking, the applicant should claim the basic design, not the exact product to be sold. By claiming the design, the patent will cover more than a copy of the product sold and prevent knockoffs from circumventing patent infringement. Consider the three figures shown below. In the far left design, taken from a figure of an issued patent claiming a watch design, the patentee has claimed many design details of the watch. The middle figure has been altered to remove portions of the watch face and the ribbing details on the side of the watch. Finally, in the right-most figure, all the interior details of the watch face have

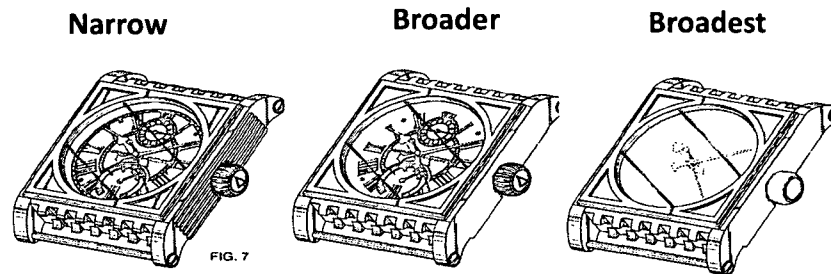
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<sup>159</sup> Dennis Crouch, *Design Patent Rejections*, PATENTLYO (Jan. 19, 2010), <http://www.patentlyo.com/patent/2010/01/design-patent-rejections.html>.

<sup>160</sup> 37 C.F.R. § 1.155 (2010).



been removed and the hands of the watch have been converted to broken lines.<sup>161</sup>



**Figure 8:** *D607,757 at Figure 7 and modifications thereof*

An accused product that would infringe a design patent directed to the figure on the left would likely need to have Roman numerals and two smaller dials whereas, an accused product that might infringe a design patent directed to the figure on the right would not need these elements. The broader the design patent (and the fewer features depicted in the figures), the larger the variety of accused products that may infringe the claimed design.

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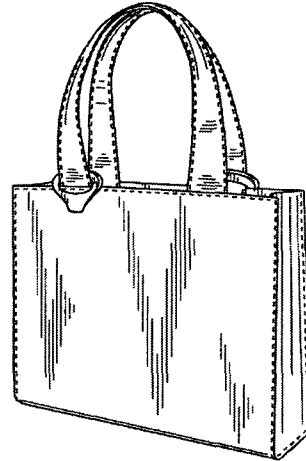
<sup>161</sup> The importance of broken lines is discussed *infra* Part V.C.3.

2. *Employ Clear Line Drawings to Depict the Claimed Design*

In addition, designs that can be depicted within clear black and white line drawings provide greater protection to patentees than designs depicted with ill-defined lines. For example, consider these two figures from design patents issued to Louis Vuitton:



**Figure 9:** *D453,070 for a Louis Vuitton Handbag*



**Figure 10:** *D433,803 for a Louis Vuitton Handbag*

The '070 patent is intended to protect a product made from a specific fabric, whereas the '803 patent is intended to protect a more generic design. The latter design patent covers a handbag made from any material, including fabric or leather, in any color.

### 3. *Judiciously Use Broken Lines to Show the Environment*

In the United States, “broken lines” may be used to depict “[s]tructure that is not part of the claimed design, but is considered necessary to show the environment in which the design is used.”<sup>162</sup> The “environment” can be changed and the design patent will still protect the design. For instance, at first glance, this design patent for Jimmy Choo sunglasses appears quite limited as it only protects a small portion of this eyeglass frame:

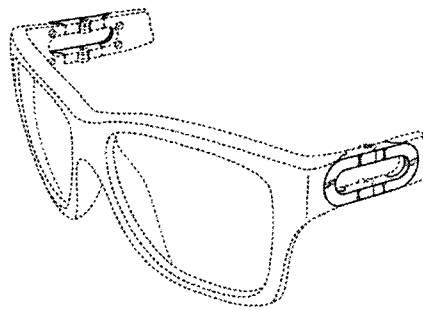


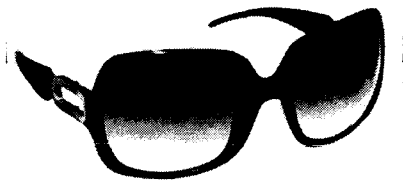
FIG. 1

**Figure 11:** *U.S. Patent No. D596,660*

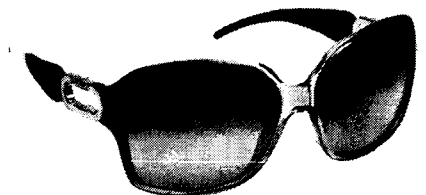
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<sup>162</sup> U.S. PATENT AND TRADEMARK OFFICE, *A Guide to Filing a Design Patent Application*, <http://www.uspto.gov/patents/resources/types/designapp.jsp> (last visited Apr. 12, 2011).

But, because the portion of the frame depicted in broken lines is only “environment” for the claimed design, the design is actually quite broad. This oval feature depicted in solid lines can cover many different products, as long as they include the “oval.” In fact, Jimmy Choo sold at least two designs of sunglasses that are protected by this design patent:



**Figure 12:** *Jimmy Choo Marge Sunglasses*<sup>163</sup>



**Figure 13:** *Jimmy Choo Monty Sunglasses*<sup>164</sup>

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<sup>163</sup> JIMMY CHOO, <http://www.jimmychoo.com/sunglasses/marge/inv/221116nld6202/> (last visited Mar. 24, 2011).

<sup>164</sup> *Id.*

But, when using broken lines, the patentee need not be as generic as the Jimmy Choo design. Consider this design patent for a high-heeled shoe with a side zipper:

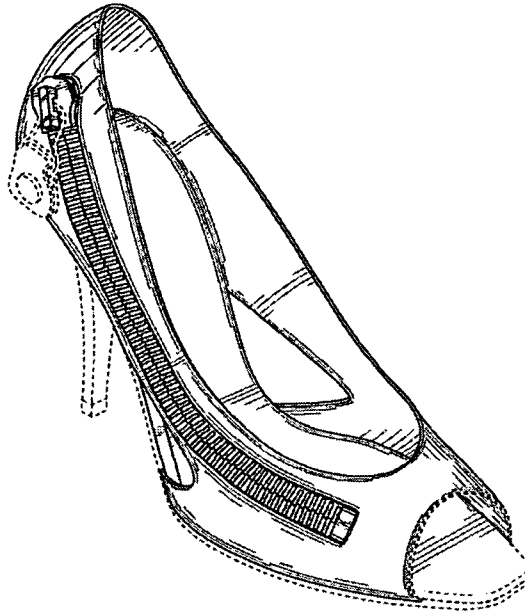


FIG. 1

**Figure 14:** *U.S. Patent No. D582,144*

Arguably, a shoe with a chunkier heel or a shoe without a peep-toe could still infringe this patent. But notice that the design includes missing portions of the shoes on the sides, as these holes are not in broken lines. This significantly narrows this design. A product that would infringe this design patent arguably requires side zipper *and* the holes on both sides of the shoe.

In contrast, this design appears to be intended to protect only the chain portion of the shoe's strap:

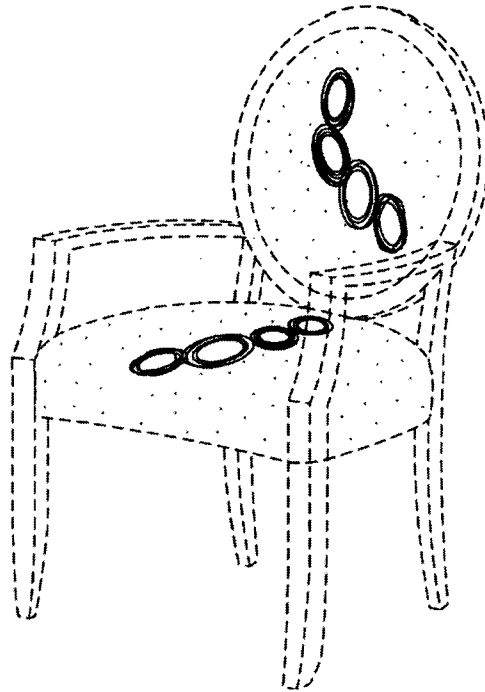


FIG. 1

**Figure 15:** *U.S. Patent No. D548,944*

But careful use of broken lines suggests that this design could be used on any type of shoe, with any height of heel, not just the exemplary shoe depicted in broken lines. Of course, this design is limited in other respects, since arguably a knockoff designer could design a similar shoe with a different collection of jewels in the front and likely not be found to infringe this patent.

Moreover, broken lines are also helpful for design patents directed to only surface ornamentation for an article. In that case, the article in which it is embodied must be shown in broken lines.<sup>165</sup> For instance, this circular surface ornamentation is depicted on a generic chair, shown in broken lines:



**Figure 16:** *U.S. Patent No. D441,543*

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<sup>165</sup> U.S. PATENT AND TRADEMARK OFFICE, *supra* note 141.

Finally, broken lines may offer a patent owner the opportunity to have one design that can be used on different products. Consider this design for “Decorative piece of footwear” by Jimmy Choo:

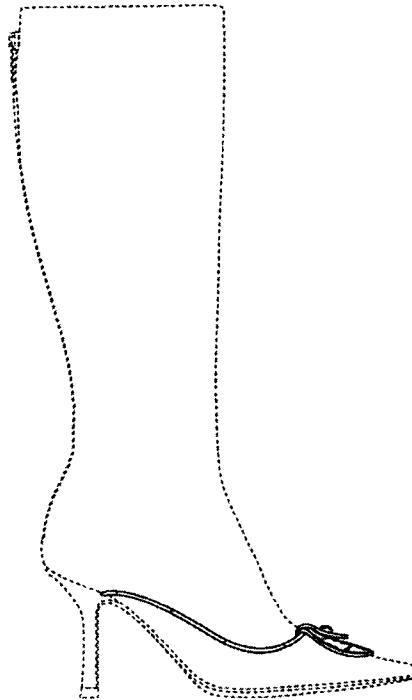


FIG. 2

**Figure 17:** *U.S. Patent No. D591,939*

At first glance, the broken lines indicate that this design covers a boot, but the design might also be used to protect a pump with a similarly shaped toe and buckle. In this case, the patentee’s careful use of broken lines has likely allowed it to have a two-for-the-price-of-one deal.

By carefully considering the elements of the design that most need protection and depicting those elements with clear drawings that use broken lines when appropriate, the applicant’s resulting patent will likely be stronger and easier to enforce.



#### D. *Infringement of Design Patents*

Once the PTO has issued a design patent, the patentee may use the patent to exclude others from making, using, selling, offering for sale, or importing infringing products.<sup>166</sup> In 2008, in *Egyptian Goddess v. Swisa*, the U.S. Court of Appeals for the Federal Circuit significantly changed the infringement standard for design patents.<sup>167</sup> Under this test, the Federal Circuit essentially asks, “[w]ould a person who buys and uses this nail buffer, and who is familiar with this type of object, confuse the accused design with the patented design?”<sup>168</sup> A finding of infringement is still possible despite minor differences between the patented design and accused product, provided that the patented design did not depart significantly from previous designs.<sup>169</sup> Conversely, if the patented design was quite similar to previous designs, then minor differences between the two may prevent a finding of infringement.<sup>170</sup>

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<sup>166</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008).

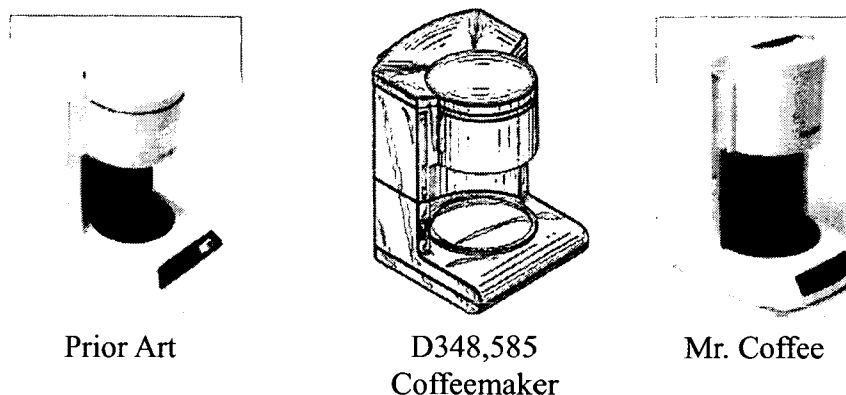
<sup>167</sup> *Id.* at 678.

<sup>168</sup> *Id.* at 681.

<sup>169</sup> *See id.* at 683 (holding that a four-sided nail buffer did not infringe upon prior designs of three-sided nail buffers because the addition of a fourth side is not minor, despite similarities between the two designs).

<sup>170</sup> *Id.*

For example, below is a comparison of a prior art coffee maker, the design patent, and a Mr. Coffee product found to not infringe by the district court:<sup>171</sup>



**Figure 18:** *Comparison of Prior Art, Patent-in-Suit, and Accused Product from Wing Shing Prods. v. Sunbeam Prods.*

In this case, the district court determined that the ordinary observer familiar with the prior art would not confuse the patented design for the Mr. Coffee product.<sup>172</sup> Some commentators have suggested that this new “ordinary observer” may have a discerning eye capable of meticulous distinctions when comparing the patented design and the accused product.<sup>173</sup> Such minor distinctions could make a finding of infringement more difficult, especially if the scope of the design patent at issue is narrow, which is why patenting the design and not the product is even more important after *Egyptian Goddess*.

#### E. Strategic Patenting of Designs

To effectively use design patents to protect fashion designs, designers need to have a strategic patent prosecution strategy.

<sup>171</sup> Wing Shing Prods. v. Sunbeam Prods., 665 F. Supp. 2d 357 (S.D.N.Y. 2009).

<sup>172</sup> *Id.* at 367.

<sup>173</sup> Lawrence R. Robins and Katherine L. Staba, *Articles: What You Need to Know About Design Patents in the Furniture Industry*, FINNEGAN (Apr. 9, 2010), <http://www.finnegan.com/resources/articles/articlesdetail.aspx?news=f4b4afc1-8f30-4420-9eb3-9c6fb84d73a6>.

### 1. *Carefully Consider Cost Efficiencies, Content, and Timing*

Choosing to apply for only a single design patent on one product of many is unlikely to provide long-term benefit to a designer, primarily because that designer is probably not lucky enough to choose the “it” product of the season. The wiser strategy is for a designer to commit to patenting several designs. As the designer becomes more experienced at filing design patent applications, she will improve her skills at identifying those parts of a particular design in need of protection. Moreover, the designer might be able to negotiate a deal with a patent attorney based on the volume of work, and the designer will become more experienced with submitting the necessary materials for the attorney to prepare each application.

One question commonly asked about fashion design patents is whether a designer with limited resources can determine ahead of time which item is worth patenting.<sup>174</sup> A designer can choose to patent an entire line or choose certain key pieces within the line that distinguish her designs from others. In addition, as explained above, the designer can choose to patent only those unique portions of the design that require protection (such as the oval shaped hinge on the Jimmy Choo sunglasses) and apply that design element to multiple products.<sup>175</sup>

In addition to selecting the right material to patent, designers must determine when to apply for patent protection. Generally, the best option is for the established designer to apply as soon as the design is finalized. This would allow time for the patent to issue, providing the earliest possible protection and deterring potential knockoff artists from the start. Alternatively, the best option for emerging designers might be to wait to see if one or more of their designs sells enough in quantity to be worth patenting. When a designer realizes that she has created a new “it” item for the season,

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<sup>174</sup> See Ferris, *supra* note 119, at 566–67 (2008) (demonstrating that only certain, unique symbols or devices have been found copyrightable and that the threshold of nonobviousness is nearly impossible to meet). In addition, “patents are extremely costly and require a lengthy application process that is largely unsuitable to the fast turnover that is characteristic of the fashion cycle.” *Id.*

<sup>175</sup> JIMMY CHOO, *supra* notes 163–64.

she immediately may file a patent, better preserving her rights in the event that a patent is issued covering the design.

## 2. *Build a Deterrent Out of Design Patents*

Fashion designers should also keep in mind that a consistent policy of design patenting may be a valuable deterrent against knockoff designers, even without having to actually file a lawsuit. Unlike utility patents, design patents are not published until they issue.<sup>176</sup> Thus, when a knockoff designer sees “patent pending” in relation to a new design, he may not know exactly what features of the new design may be protected in the future.<sup>177</sup>

Furthermore, if a designer has a reputation for applying for design patent protection and enforcing his rights once the patent issues, knockoff designers may avoid that designer’s work altogether to prevent the potential cost and disruption to his business caused by being sued. Those who routinely knock off designs might reconsider selling knockoff goods if they are informed that the original designer regularly applies for patent protection and enforces those rights.<sup>178</sup> These conglomerates could be pulled into lawsuits just for selling infringing goods.<sup>179</sup>

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<sup>176</sup> See 35 U.S.C. § 122(b)(1)(A) (2006), available at [http://www.uspto.gov/web/offices/pac/mpep/consolidated\\_laws.pdf](http://www.uspto.gov/web/offices/pac/mpep/consolidated_laws.pdf) (stating that no patent will be published until 18 months after filing, unless by request of the patent applicant); see also *Patent Information*, NEUSTAL LAW OFFICES, <http://www.patent-ideas.com/patents.htm> (last visited Mar. 25, 2011) (“Beginning March 2001, the USPTO began ‘publishing’ utility patent applications (not design patent applications) filed on or after November 29, 2000 (including International applications). In exchange for the publication of a patent application, patentees may be able to obtain a reasonable royalty during the period beginning on the date of publication of the application by the USPTO and ending on the date the patent is issued (‘provisional rights’). An application may be published earlier than the end of such eighteen-month period at the request of the applicant. An application will not be published if an applicant makes a request upon filing the application certifying that the invention has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires eighteen-month publication.”).

<sup>177</sup> See 35 U.S.C. § 122 (2006).

<sup>178</sup> See Evangeline Cafe, *Legally Chic: Should Fashion Designs Receive Copyright Protection?—Local Asian American Experts, Designers Weigh In on the Debate*, NORTHWEST ASIAN WEEKLY (Feb. 17, 2011) <http://www.nwasianweekly.com/2011/02/legally-chic-should-fashion-designs->

One commentator suggests that design patents gain strength and power when “acquired in bulk.”<sup>180</sup> Multiple patents on a similar product create a portfolio that will create significant work for a competitor to avoid if they want to enter the same market as the claimed design.<sup>181</sup> In addition, these deterrents could help build a strong brand image for the rising fashion designer or maintain one for a more established designer.

### 3. *If You Can't Beat Them, Join Them—Licensing Your Design Patents*

In 2008, when Stuart Weitzman, a popular shoe designer, saw a pair of \$45 flats on the JCPenney web site, he immediately noticed that they looked similar to his pair of \$215 flats.<sup>182</sup> Weitzman promptly sued.<sup>183</sup> However, not all popular designers take this route. Isaac Mizrahi, for example, started designing for Target in 2003.<sup>184</sup> He signed a five-year deal with the mass market retailer to sell a clothing line under his name.<sup>185</sup> Many other popular designers have followed suit including Vera Wang for Kohl's and Stella McCartney for H&M.<sup>186</sup> These designers are effectively controlling how these lower-end stores knockoff their higher-end work.

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receive-copyright-protection-local-asian-american-experts-designers-weigh-in-on-the-debate/ (claiming that copyright protection might better hold conglomerates that act as fast-fashion companies accountable).

<sup>179</sup> 35 U.S.C. § 271(b) (stating that “whoever actively induces infringement of a patent shall be liable as an infringer”); see also *The IDPPPA—Is the Third Time a Charm?*, COLUM. BUS. L. REV., <http://cblr.columbia.edu/archives/11357> (last visited Apr. 11, 2011) (claiming that copying and selling designs at a cheaper price will only lead to extensive lawsuits).

<sup>180</sup> Gene Quinn, *Design Patents*, IPWATCHDOG (Jan. 3, 2008, 5:20 PM), <http://ipwatchdog.com/patent/design-patent/>.

<sup>181</sup> *Id.*

<sup>182</sup> Jana, *supra* note 112.

<sup>183</sup> Kathianne Boniello, *Knock It Off, Heels!*, NEW YORK POST (Jan. 27, 2008, 3:26 AM), [http://www.nypost.com/p/news/regional/item\\_wTd08CMHqHu6vKEL1tuBmJ](http://www.nypost.com/p/news/regional/item_wTd08CMHqHu6vKEL1tuBmJ).

<sup>184</sup> Watkins, *supra* note 13, at 57.

<sup>185</sup> Jana, *supra* note 112.

<sup>186</sup> Watkins, *supra* note 13, at 57.

This option may, however, seem available only to the most popular, successful designers. With a portfolio of design patents though, even lesser-known designers could license their work to mass market retailers. As explained earlier, a properly crafted design patent may have elements that can be utilized in multiple products.<sup>187</sup> The patent owner could simply decide that a certain version of the design would be reserved for the higher-end clientele, but that same designer could reinterpret the look for the lower-end set. Through licensing of their design patents, designers would be in the driver's seat and in a much better position to control their own destinies.

#### F. *The Overall Utility of Design Patents for Fashion Design*

Despite the many advantages of design patents, many scholars and practitioners erroneously believe that design patents are not useful for fashion. Dissenters often say (1) that the costs of getting the design patent would override the benefits;<sup>188</sup> (2) that the application process for a design patent takes longer than the production and consumption cycle of the design;<sup>189</sup> and (3) that design patents are impractical because they last too long.<sup>190</sup> In

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<sup>187</sup> See *infra* Part V (regarding information on crafting a design patent to cover multiple products).

<sup>188</sup> Ferris, *supra* note 119, at 567 ("Furthermore, patents are extremely costly and require a lengthy application process that is largely unsuitable to the fast turnover that is characteristic of the fashion cycle.").

<sup>189</sup> Kristin L. Black, *Crimes of Fashion: Is Imitation Truly the Sincerest Form of Flattery?*, 19 KAN. J.L. & PUB. POL'Y 505, 507 (2010); see Howard, *supra* note 49, at 350 ("Though conceivably eligible for design patents, the lengthy application process has made that form of protection impractical."). But note that the damages for design patent infringement start at the time of filing for the application, not when the patent is received. See U.S. PAT. AND TRADEMARK OFF., *General Information Concerning Patents: Publication of Patent Applications*, <http://www.uspto.gov/web/offices/pac/doc/general/> (last visited April 2, 2011).

<sup>190</sup> Lisa J. Hedrick, *Tearing Fashion Design Protection Apart at the Seams*, 65 WASH. & LEE L. REV. 215, 222-224 (2008); Tsai, Julie P., *Fashioning Protection: A Note on the Protection of Fashion Designs in the United States*, 9 LEWIS & CLARK L. REV. 447, 456 ("Clothing is inherently functional, hence only certain aspects of the fashion design are eligible for design patent protection. Consequently, the overall fashion design is unlikely to be protected by a design patent.").

practice, the theory that design patents are impractical for all fashion designs fall short, as many practitioners and designers have found a place for design patents in the fashion industry.<sup>191</sup>

First, spending \$10,000 to protect a \$60 Shashi bracelet may not necessarily seem like a good business choice, and many commentators do agree with this initial conclusion.<sup>192</sup> The cost of obtaining and enforcing a design patent might be miniscule in comparison to losing a design to the knockoff industry.<sup>193</sup> In practice, it is possible to obtain a design patent for around the cost of the designer handbag.<sup>194</sup> If a designer becomes adept at regularly applying for design patents, he will enjoy an economy of scale that may bring this cost down even further. Furthermore, small designers might qualify for half-price fees.<sup>195</sup> Enforcement costs also may seem reasonable when compared to the lost profits if a popular design is knocked off. In addition, while the “trend cycle” may be considered to be days or weeks or months,<sup>196</sup> the

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<sup>191</sup> See *Design Patents and the Fashion Industry*, *supra* note 33 (claiming that certain fashion industry markets, including eyewear, shoes, handbags, and jewelry, have embraced design patents as useful).

<sup>192</sup> See Ferris, *supra* note 119, at 567 (“Furthermore, patents are extremely costly and require a lengthy application process that is largely unsuitable to the fast turnover that is characteristic of the fashion cycle.”); Nicole Giambarese, *The Look for Less: A Survey of Intellectual Property Protections in the Fashion Industry*, 26 *TOURO L. REV.* 243, 245 (2010) (“Finally, patent protection is available; however, it is only applicable in very limited circumstances in fashion. The problem with patent protection is that trends change almost monthly, and there is a long, costly process to be afforded a patent.”); see *infra* Part II.B (discussing Shashi bracelets).

<sup>193</sup> See *infra* Part II.B (discussing Shashi bracelets).

<sup>194</sup> Compare GUCCI, *supra* note 43 (pricing a Gucci bag at \$13,000), with *Design Patents and the Fashion Industry*, *supra* note 33 (pricing a design patent application at \$1,350). Even with enforcement fees, the sale of multiple Gucci totes would more than make up for the patent costs especially if it could deter the knockoff industry and/or get retroactive damages from litigating the large knockoff corporations.

<sup>195</sup> *Design Patents and the Fashion Industry*, *supra* note 33.

<sup>196</sup> See *Fashion Trend Cycle*, FASHION TIPS (Feb. 28, 2011), <http://www.freemethodistworld.org/fashion-trend-cycle.html>; Cynthia Nellis, *Hot or Not? When Fashion Trends Die*, ABOUT.COM <http://fashion.about.com/od/latesttrends/a/trendover.htm> (Apr. 11, 2011); Denise

knockoff manufacturers may continue to sell knockoff products well after the designer has moved on. A design patent allows the designer to enforce his patent rights and exclude others from using the claimed design for the full 14-year term of the patent, regardless of whether he is still selling a product that embodies that design.<sup>197</sup>

Second, many scholars and practitioners argue that the application process for a design patent is too slow and cumbersome in an industry where most designs will only last a few months.<sup>198</sup> While the average amount of time to issue is approximately fifteen months, this average represents all design patents as opposed to being fashion-specific design patents.<sup>199</sup> Fashion-specific design patents tend to be simpler (and thus should be quicker to examine and less likely to be rejected if the drawings as originally filed are well-crafted) than more complicated products such as automobile parts or building designs.<sup>200</sup> Furthermore, if a fashion patent were to take less than fifteen months to issue, then a savvy fashion designer could file the patent application at the sketching stage and be well on the way to getting the patent issued by the time the product hits the stores.<sup>201</sup> Moreover, as explained above, designers

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Winterman, *The Life Cycle of a Fashion Trend*, BBC NEWS MAGAZINE (Sept. 22, 2009), <http://news.bbc.co.uk/2/hi/8262788.stm>.

<sup>197</sup> Notably, the design patent owner's right to exclude others from practicing the patented design is not contingent upon the design patent owner *ever* selling the patented design. Section 271 provides a right to exclude others, but does not require the patent owner to actually sell a product embodying the patented design. See 35 U.S.C. § 271 (2006).

<sup>198</sup> See Hedrick, *supra* note 190, at 224; Irene Tan, *Knock It Off, Forever 21! The Fashion Industry's Battle Against Design Piracy*, 18 J.L. & POL'Y 893, 905 (2010).

<sup>199</sup> U.S. PAT. AND TRADEMARK OFF., DESIGN PATENT REPORT: PARTS A1, A2, B (1977–2009), available at <http://www.uspto.gov/web/offices/ac/ido/oeip/taf/design.htm>; see *Design Patents and the Fashion Industry*, *supra* note 33.

<sup>200</sup> Compare U.S. PAT. AND TRADEMARK OFF., *supra* note 199, with *Design Patents and the Fashion Industry*, *supra* note 33 (contrasting the length of time usually required for design patents to issue for fashion items versus other items).

<sup>201</sup> See Laura C. Marshall, *Catwalk Copycats: Why Congress Should Adopt a Modified Version of the Design Piracy Prohibition Act*, 14 J. INTELL. PROP. L.



could file using the expedited examination procedure at the PTO and potentially have the design patent issued within in an average of five months.

Finally, many scholars have argued that design patents are ill-suited for the fashion industry because they last for fourteen years.<sup>202</sup> On its face, this argument does not seem relevant to protecting a designer's intellectual property rights. It could be argued, though, that design patents protect the item for too long, perhaps inhibiting innovation and slowing the creativity of designers who at a moment's notice must hustle to create new designs in order to continue being the next best thing.<sup>203</sup> On the other hand, consider that some popular designs might actually remain popular for fourteen years (such as Mr. Gladwell's Hush Puppies), and often a design will return as a comeback.<sup>204</sup> Or perhaps a designer might choose to bring back a "retro" design she originally created years before. Finally, a designer could choose to license her design to lower-end markets as the design's high-end popularity wanes. If the design's popularity passes, then no harm is really done to the rest of the industry by continuing to protect the claimed design. Designers would not likely pay the costs of enforcement should a knockoff come around after the trend cycle is over. Therefore, in practice, the market may in fact be the one to set the timeline on how useful design patent enforcement will be.

## VI. CONCLUSION

Fashion designers are artists and entrepreneurs. Both of these identities are entitled to intellectual property protection, just as inventors find in utility patents and authors in copyrights. Copyright legislation for fashion design is still pending and should it pass the new statute will take time to settle into a predictably enforceable process. In the meantime, design patents offer a valuable tool for the fashion designer's intellectual property

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305, 310 (2007) (claiming that the time length between initial sketches and final manufacture is roughly 18 to 24 months).

<sup>202</sup> Tan, *supra* note 198, at 906; *Patent Information*, *supra* note 176.

<sup>203</sup> Raustiala and Sprigman, *supra* note 55.

<sup>204</sup> Winterman, *supra* note 196.

toolbox. Moreover, should the copyright legislation come to fruition, future designs will still likely find that a combination of multiple intellectual property tools provide the best protection in the long-run. While a design patent might not seem ideal for certain aspects of fashion design, it has many often-overlooked advantages. In the future, savvy designers may find that strategic design patenting could play a key role in protecting their rights and building their brands.

